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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,173	09/29/2005	Ken'ichi Fujii	00862.023538.	4237
5514 7590 05/17/2011 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER NEURAUTER, GEORGE C				
ART UNIT 2447		PAPER NUMBER		
MAIL DATE 05/17/2011		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,173

Applicant(s)

FUJII ET AL.

Examiner

GEORGE NEURAUTER

Art Unit

2447

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4-6-9, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4-6-9, 11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/17/2011, 5/2/2011
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 March 2011 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 2-4, 6-9, 11, 13, and 14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-4, 7-9, 11, 13, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication 2004/0167974 to Bunn et al.

Regarding claim 2, Bunn disclosed a wireless communication device (see throughout the references regarding "mobile-communication device") comprising:

a network detection unit adapted to detect a plurality of wireless networks; a network connection unit adapted to connect to a wireless network detected by the network detection unit; a printer searching unit adapted to search for one or more printers having a predetermined print function within the wireless network connected to by the network connection unit; a display unit adapted to selectably display information associated with one or more printers detected by the printer search unit, every time the printer search unit detects one of the one or more printers having the predetermined print function; and a printer connection unit adapted to, when an operator selects a printer associated with the information displayed by the display unit, terminate searching by the printer search unit and connect to the selected printer. (see at least paragraphs 0049 and 0051-0052)

Regarding claim 3, Bunn disclosed the device according to claim 2, further comprising a storage detection unit that stores, in a memory, identification information of the one or more printers detected by the printer searching unit and wherein the display unit selectably displays the identification information stored in the memory. (see at least paragraph 0051)

Regarding claim 4, Bunn disclosed the device according to claim 2, wherein the wireless communication device is an image sensing device or a storage device for executing a storage process of a sensed image. (see at least paragraphs 0034-0035)

Regarding claim 7, Bunn disclosed the device according to claim 2, further comprising: a determination unit adapted to determine if a detected beacon signal is in an ad_hoc ("direct") communication mode or in an infrastructure ("indirect")

communication mode, and, when the determination unit determines that the detected beacon signal is in the ad hoc communication mode, the printer searching unit transmits a search signal for searching for the printer having the predetermined print function toward a printer that sent the detected beacon signal, and, when the determination unit determines that the detected beacon signal is in the infrastructure mode, the printer searching unit transmits the search signal toward an access point that sent the detected beacon signal. (see at least paragraph 0051)

Regarding claim 8, Bunn disclosed the device according to claim 2, further comprising a registration unit adapted to register, in a memory, information associated with the printer connected to by the printer connected unit in accordance with an indication by the operator. (see at least paragraphs 0071-0072)

Regarding claim 9, Bunn disclosed the device according to claim 8, further including a mode for executing a process for establishing a wireless communication based on the information registered by said registration unit. (see at least paragraphs 0071-0072)

Regarding claim 11, Bunn disclosed a wireless communication device comprising:

a beacon detection unit adapted to detect a beacon signal; a searching unit adapted to search for a printer having a predetermined print function, wherein, when the detected beacon signal is sent by a wireless communication device in an ad hoc mode, the searching unit transmits a search signal for searching for the printer having the predetermined print function to the wireless communication device that sent the

detected beacon signal, and, when the detected beacon signal is sent by an access point in an infrastructure mode, the searching unit transmits the search signal to an infrastructure network through the access point; and a display unit adapted to selectively display information associated with a printer that responded to the search signal. (see at least paragraphs 0049 and 0051-0052)

Regarding claim 13, Bunn disclosed a method performed by a wireless communication device, the method comprising:

detecting a plurality of wireless networks; connecting to a wireless network detected by the network detection unit; searching for one or printer having a predetermined print function within the wireless network connected to; and displaying information associated with one or more printers detected by the printer search unit, every time the printer search unit detects one of the one or more printers having the predetermined print function; and when a printer associated with the displayed information is selected, terminating the searching and connecting to the selected printer. (see at least paragraphs 0049 and 0051-0052)

Regarding claim 14, Bunn disclosed a method performed by a wireless communication device, the method comprising: detecting a beacon signal; searching for a printer having a predetermined print function; when the detected beacon signal is sent by a wireless communication device in an ad hoc mode, transmitting a search signal for searching for the printer having the predetermined print function to the wireless communication device that sent the detected beacon signal; and, when the detected beacon signal is sent by an access point in an infrastructure mode, transmitting the

search signal to an infrastructure network through the access point; and selectably displaying information associated with a printer that responded to the search signal. (see at least paragraphs 0049 and 0051-0052)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bunn in view of US Patent Application Publication 20030050963 to Lamming et al.

Regarding claim 6, Bunn disclosed the device according to claim 2.

Bunn may be interpreted as not expressly teaching wherein, when the one or more printers having the predetermined print function are not detected, no signal is received in response to a search signal within a predetermined period of time, and an error display is made, however, Lamming did disclose these limitations (see at least paragraph 0125)

It would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of these references since one of ordinary skill in the art could have combined the elements as claimed by known methods by integration of software routines in order to provide a more comprehensive and useful computer program product and that, in combination, each element merely performs the same function as it does separately and would have recognized that the results of such a combination of software routines would have been predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GEORGE NEURAUTER whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joon Hwang, can be reached on 571-272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C Neurauter, Jr./
Primary Examiner, Art Unit 2447